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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,508	02/20/2004	Laszlo Domokos	TS1224 (US)	7584
23632	7590	10/31/2007		
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463			EXAMINER NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			10/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,508

Applicant(s)

DOMOKOS ET AL.

Examiner

Cam N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/20/07 (an election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 13-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on as filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date as filed.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Election/Restrictions

1. Applicant's election with traverse of Group II, claims 8-12, in the reply filed on August 20, 2007 is acknowledged. The traversal is on the ground(s) that "the Examiner's restriction is improper; since, the search and examination of the entire application can be made without serious burden to the Examiner. See MPEP 803". This is not found persuasive because the search required for Group I is not required for Group II and Group III, thus if all groups are searched, and additional burden is imposed on the Office due to three different search areas being required. However, in accord with the MPEP rule, once the elected product claims are found allowable, the nonelected claims (containing the allowable subject matter) will be rejoined. For purpose of search and examination on the merits, the restriction must be maintained.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7 & 13-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 20, 2007.

Claim Objections

3. Claims 8 & 12 are objected to because of the following informalities:

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- A. In claim 8, line 8, "aluminium" should be changed to --aluminum--.
- B. In claim 8, line 18, -- , -- should be inserted before "wherein".
- C. In claim 8, line 18, -- a -- should be inserted after "wherein".
- D. In claim 12, line 5, -- wt%-- should be inserted after "15 to 30".

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

- 4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 5. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. Regarding claim 8, line 7, the proper Markush terminology is --Z represents one or more elements selected from the group consisting of...boron and zinc--.
- B. Regarding claim 10, the phrase "XRD-amorphous" does not particularly point out what applicants intend. Does applicants mean the catalyst of claim 9 having an XRD-amorphous structure?

Claim Rejections - 35 USC § 102(b)/103

- 6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakamura et al., "hereinafter Nakamura", (US Pat. 4,408,067).

Nakamura discloses a catalyst, which has the empirical formula $Ti_aMe_bX_cO_d$, wherein Me represents at least one element selected from the group consisting of Cu, Ag, Au, Sn, Pb, Zr, V, Bi, Mo and W and X represents Si and subscripts a, b, c, and d designate the atomic ratio and when a is 1, b is 0.01 to 12, c is 0 to 12 and b+c is 0.01 to 12 and d is the oxygen content of the catalyst formed by the combination of the above components (see col. 10, claim 1). The catalyst may be supported on a carrier (see col. 4, ln 1-4 & Example at col. 5, "Catalyst 2").

Regarding claim 8, the claimed molar ratio limitations appear met by the teaching of the reference because they are falling within the disclosed ranges (see above).

With respect to the product-by-process limitations in claim 8, while the catalyst of Nakamura is not made by the same process, the catalyst disclosed is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, even though the process limitations in the claims are not disregarded, they have no bearing on the patentability of the claims product per se. See *In re Thorpe*, 227 USPQ

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964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP 2113*.

Regarding claims 10-11, while Nakamura is silent with respect to the XRD diffraction pattern of the disclosed catalyst, it is inherent and expected that his catalyst would possess the same properties because the catalyst disclosed is the same as being claimed.

Citations

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared.

Conclusion

9. Claims 8-13 are pending. Claims 8-13 are rejected. No claims are allowed.

Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

October 29, 2007

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